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3 **REMARKS**

4 1. Amendment of the Claims:

5 Claims 1, 4 and 16 were rejected based on the second paragraph of 35 U.S.C. 112 for
6 failing to particularly point out and distinctly claim the subject matter which the applicant
7 regards as his invention. In response, Claims 1, element (c), and Claims 4 and 16 have been
8 amended to correct these errors.

9 In addition, Claim 1, step (f) has been amended to recite that step of selecting the
10 advertising material uses the network identity information, the physical location information,
11 and the network activity information all found in the user file. Support for the new language
12 is found in the Specification on page 5, lines 5-9, page 8, line 21, and page 9, lines 1-2.

13 Claims 3 and 4 has been amended to correct antecedent basis problems noted by the
14 Examiner.

15 Claim 16 has been amended to make it dependent on Claim 1.

16 Claims 1-5, 7, 13, 14, 16, 17 and 19 have been rejected under 35 U.S.C. 103 as being
17 obvious based on Obradovich et al. (U.S. Patent No. 6, 133,853) in view of Roth (U.S. Patent
18 No. WO 98/34189). According to the Examiner, Obradovich et al. discloses all of the
19 elements (a)-(g) recited in Claim 1. The only feature recited in Claim 1 and lacking in
20 Obradovich et al. is the step of providing of ads based on network activities. According to
21 the Examiner, this feature has been admitted as being old and also is disclosed in Roth.
22 Thus, one skilled in the art would have known to combined Roth's ad targeting by
23 connecting and cookies teachings to that of Obradovich et al., thus making Claim 1 obvious.

1 Reconsideration of the Claims 1, 3-5,7,13,14,16,17,and 19 is now requested for the
2 following reasons:

3
4 A. Cited References do not Teach the Method Invention in Claim 1.

5 In order to establish a prima facie case of obviousness, the Examiner must cite
6 references that teach the invention as recited in the Claims. The Applicant submits that
7 because the cited references do not teach the invention, a prime facie case of obviousness has
8 not been established.

9 Claim 1 (Amended) recites a method of marketing to a user of an electronic device
10 connected via a wireless connection to computer wide area network comprising a plurality of
11 steps (a) thru (g). The unique combination of steps enables the operator of a server or an
12 advertiser connected to the network to continuously or intermittently transmit advertisements
13 to users as they travel in a region serviced by a wireless telephone system. The user controls
14 an electronic device that intermittently or continuously communicates with the computer
15 wide area network via a wireless network as the user moves in the region. The electronic
16 device is coupled to a physical location means (i.e. a GPS receiver) that determines the exact
17 location of the electronic device (hence the user) as the user moves in the region. When
18 connected to the computer wide area network, the physical location information is uploaded
19 to the server. The physical location information, the user's network identity and network
20 connection activities are then collected and stored in a user file. An advertiser or the operator
21 of the server then selects specific ads to transmit to the user based on the three pieces of
22 information in the user file.

1 Obradovich, et al. discloses a personal communication and position system for
2 communicating data that includes global positioning-coded information. The system is
3 specifically designed to address the problem that a single data base can not contain enough
4 information to fulfill the request for physical location information for every consumer. (see
5 Col. 2, lines 10-15). This problem is addressed by tagging file information with GPS
6 encoded data. For example, a personal communication device (PDA) may be used as a
7 telephone to call for directory information for the telephone number of a business. The
8 telephone number information from the directory service may include GPS encoded data so
9 containing the address of the business and a detailed map of the area showing the physical
10 location of the business. (see discussion Col. 3, lines 1-24). In another example, the PDA is
11 used to download information over a wide area network for businesses which are referenced
12 in radio broadcasts. According to the inventor, users use their PDAs to access websites on
13 the wide area network to obtain downloaded yellow page type information, maps or GPS
14 encoded information. (see discussion on Col. 3, lines 25-44).

15 Contrary to the Examiner's understanding, Obradovich et al. does not disclose a
16 method of marketing that selects advertisements using the electronic device's network
17 identification information and physical location. While physical location information, such
18 as the business address or location on a map, may be downloaded to the electronic device, it
19 is not used to select advertisements or the users.

20 On Col 24, lines 37-67, and Col. 25, the PCD is described as including a position
21 monitoring function with four different options. Contrary to the Examiner's understanding,
22 the fourth option, referred to as MOVE option, is identical to element (c) in Claim 1. The
23 Move option is a feature that enables the user to enter a distance that he or she intends to

1 travel (i.e. 5 miles) and his or her email address into his or her PCD. During use, this
2 information is sent to the server. When the PCD reconnects to the server, the physical
3 location of the user is transmitted to the server which then determines whether the distance
4 has been reached. No disclosure or suggestion is made in Obradovich et al. whereby the
5 physical location is transmitted to the user file on used to select advertisements or to selected
6 users.

7 Regarding the Examiner's comment that the use of a PCD for credit card
8 authorization as also uses step (c) of determining the physical location of the device when
9 connected to the wide area network, the Applicant agrees. However, it should be pointed out
10 that the physical location information is not used to select advertisements nor users. It is only
11 used to deter credit card theft not marketing or advertising as recited in Claim 1. .

12 In the Office Action, the Examiner stated that when Obradovich's system is used in
13 credit card authorization, a user file is created that contains network identity information,
14 physical location information of the electronic device, and network connection activity
15 information. The Applicant is able to find evidence of this finding in Obradovich et al and ;
16 disagrees with this assumption. If a user file is created as the Examiner proposes it would
17 only contain network identity information and physical location information. It would not
18 contain network activity information. In the Specification (see discuss on page 4, lines 19-
19 22, page 8, lines 2-9), the network activity information is defined as information of the
20 websites or files visited on the wide area network. The act of determining whether the user's
21 physical location has changed to deny or authorize credit, or whether the user has previously
22 requested credit approval as disclosed in Obradovich et al. is not the same as monitoring
23 websites or files visited by others. Also, no disclosure or suggestion is made in Obradovich

1 et al. that the visitation of the credit agency's website and not requesting credit approval on
2 an early date, is monitored by the credit agency and placed into a user file.

3 Another distinguishing feature is that in Obradovich's system the ads are only
4 transmitted to the user when the user connects to a business website (see discussion regarding
5 yellow page type information, Col. 3, lines 20-30). As admitted by the Applicant, and as
6 shown in Roth, it is widely known to transmit ads to visitors to a website. Examples of such
7 ads are the annoying "pop up" ads" commonly seen today. The type of ads presented to the
8 user are determined by the presence of "cookies" placed on the user's computer when he or
9 she initially visits the website. If the user never visits the website, neither "pop up" ads nor
10 cookies can be sent to the user's computer.

11 In Applicant's method, transmission of an ad is not dependent upon the user's prior
12 visitation to the business website. While a "cookie" may be deposited on the visitors
13 computer to indicate that the user is a return visitor, it is not required.

14 The Applicant submits that the two combined references do not teach the invention
15 recited in Claim 1 and, therefore, a prime facie case for obviousness has not been established.

16 B. The Method recited in Claim 1 Provides Unexpected Results that Support a
17 finding of Non-obvious.

18 The Applicant submits that the invention recited in Claim 1 enables an advertiser or
19 operator to select and transmit targeted ads to target users according to three pieces of
20 information in the user's file. Unlike, the system disclosed in Roth, which uses a "cookie" to
21 select ads and to target users, Application method uses the physical location of the user. For
22 example, if a user who had earlier visited the website of a BMW automobile dealership in
23 Seattle, was traveling from Seattle to Portland with an wireless electronic device connected

1 to the Internet, ads from other BMW automobile dealers (i.e in Tacoma, Olympia, Portland)
2 Seattle, could be transmitted to the user. The ads from the dealers would change as the user's
3 physical location changes. Using user files that contain three pieces of information enables
4 advertisers to fine tune and target their advertisements and users for greater efficiencies than
5 would be obtained if only the network identity information and network activities
6 information are used.

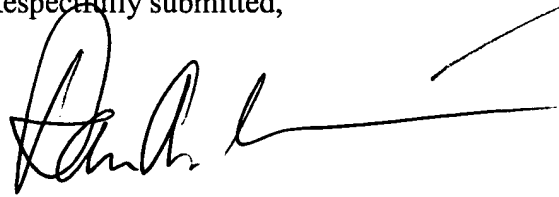
7 C. No Suggestion to Combine or Modify the Reference has been Provided

8 Another element of a prime facie case to establish obviousness is that the Examiner
9 provide some reason, suggestion, motivation, from the prior art as a whole for the person of
10 ordinary skill to have combined Obradovich et al. with Roth. According to the Examiner,
11 (see page 7 in the above referenced Office Action), it would have been know to a person of
12 ordinary skill to have to combined Roth's targeting of ads using network connection
13 activities and "cookies" with Obradovich et al., merely because such a combination would
14 extend the extensive power of the Internet to better service the mobile user. The Applicant
15 disagrees. How does the combination of Roth's targeting of ads using network connections
16 and "cookies" when combined with Obradovich et al "extend the extensive power of the
17 Internet" when both references fail to disclose the use of the physical location information to
18 select target ads? How does the combination of Roth's use of network connections and
19 "cookies" along with the use of physical location information as recited by the Examiner,
20 provide a method of marketing that enables an advertiser to select ads and better target user".
21 The Applicant submits that the Examiner must provide some sufficient reasoning for
22 combining the references is more than "to extend the extensive power or the Internet". If

1 such a reasoning can not be stated, then it is assumed that the Examiner improperly used used
2 hindsight.

3 For all of the above stated reasons, Notice of Allowance should be granted.

4 Respectfully submitted,

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7 DEAN A. CRAINE

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VERSION WITH MARKINGS

TO SHOW CHANGES

MADE TO CLAIMS

CLAIMS

I claim:

1. (Amended) A method of marketing to a user of an electronic device connected via a wireless connection to a computer wide area network, comprising the following steps:

a. selecting an electronic device connected to said computer wide area network;

b. selecting a server connected to said computer wide area network;

c. determining the [network identity and] physical location of said electronic device when connected to said computer wide area network;

d. determining [said] the network identity information and [said] the network connection [activities] activity information of said electronic device when connected to said computer wide area network;

e. creating a user file containing said network identity information of said electronic device, physical location information of said electronic device, and said network connection [activities] activity information of said electronic device when connected to said computer wide area network;

f. selecting advertising material to be sent to said electronic device using said network identity information, said physical location information and said network activity information in said user file; and

g. transmitting said advertising material to said electronic device over said computer wide area network using said network identity information in said user file.

3. (Amended) A method of marketing, as recited in Claim 1, wherein the step [(b)] (c) of determining the physical location of said electronic device is accomplished using a global

1 positioning satellite system which provides global coordinate information of said electronic
2 device when connected to said wide area network.

3
4 4. (Amended) A method of marketing, as recited in Claim 1, wherein said step (c) [is
5 carried out] of determining the physical location of said electronic device is accomplished by
6 a wireless modem connected to said electronic device and [used to communicate with said] a
7 wireless telephone network[, said wireless telephone network] capable of determining the
8 physical location of [said] a wireless modem when connected [to said wireless telephone
9 network] thereto. [and moving throughout the region serviced by said wireless telephone
10 network.]

11
12 7. A method of marketing, as reciting in Claim 1, wherein the step (c) of determining
13 the network connection activities of said electronic device is carried out by determining the
14 existence of "cookies" on said electronic device.

15
16 13. A method of advertising as recited in Claim 1 wherein step (c) is carried out using
17 information transmitted by said electronic device when connected to said computer wide area
18 network.

19
20 14. A method of marketing, as recited in Claim 1, wherein said step (c) is carried out by
21 a cellular telephone system capable of determining the physical location of a cellular
22 telephone used to connect to said wide area network.

1 16. (Amended) A method of marketing, as recited in Claim [15] 1, wherein said step
2 [(a)] (d) of [identifying] determining said network identity of said electronic device is
3 accomplished by determining the numerical network address assigned to said electronic
4 device.

5
6 17. A method of marketing, as recited in Claim 1, wherein said step (c) of determining
7 the network identity and said network connection activities from said electronic device is
8 accomplished using client software loaded into said electronic device to transmit said
9 information to said server.

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11 19. A method of marketing, as recited in Claim 1, wherein in step (d) said server collects
12 personal data of said user of said electronic device and adds it to said user file.

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